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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/751,249	12/29/2000	Leslie Los	00-091-DSK	9273

7590 10/14/2003
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EXAMINER

KARLSEN, ERNEST F

ART UNIT PAPER NUMBER

2829

DATE MAILED: 10/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/751,249

Applicant(s)

LOS ET AL.

Examiner

Ernest F. Karlson

Art Unit

2829

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7-22-03.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7, 19 and 21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 19 and 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

The formal drawings filed April 18, 2001 are objected to for containing new matter. The formal drawings contain Figure 6B which was not previously presented. The formal drawings are disapproved by the examiner. In answer to Applicant's arguments it is noted that because it is not clear what a straight feed-through connector is it cannot be clear how an auxiliary piece fitted to it would be structured.

Claims 1-7, 19 and 21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

It is still not clear what is meant by a "straight feed-through connector". Applicant has argued that the term "straight feed-through connector" is known to those of ordinary skill in the art, but a search of EAST using the phrase "straight feed-through connector" provides no hits. In other words no patent published since 1971 contains the phrase "straight feed-through connector". Applicant's example of a Molex interposer is inadequate since no details are given for a critical feature. What does a Molex interposer look like? No information is available in the disclosure. It is not clear how the connector to be used in the method of claim 1 is to be structured. It is not clear how the limitations of claims 2-4 would be implemented.

Claims 1-7, 19 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not clear what all the claimed steps are because it is not clear what all the elements used to perform the steps are.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 6, 7, 19 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Mitchell, Jr.

The apparatus of Mitchell, Jr. includes a flexible circuit 30 (see Figure 1) intended to have the pins 24 of a module 20 (see Figure 3) pass through locking lines formed by contacts 35. The pins and the casing of the module 20 are considered a straight feed-through connector. The module 20, as all skilled in the art know, would contain a chip or chips connected by very small wires to pins 24. Looking at Figure 2 the portion of the flexible circuit that contains terminals 34i is considered one end of the flexible circuit and the portion that contain terminals 34e the opposite end of the circuit. The apparatus of Mitchell, Jr. is intended to be used for maintenance tests under operating conditions. See column 4, lines 46 to 52 of Mitchell, Jr. Therefore in use the method of using the apparatus of Mitchell, Jr. in sampling data signals would be to connect the chip or chips using the module 20 and the pins 24 to a printed circuit board. The module and the pins form a straight feed-through connector. One end of the flexible circuit 30, that which contains the terminals 34i, is attached to the pins and the opposite end is connected to

test apparatus via probes which inherently has a display. If the results of the test cannot be displayed the test would be useless. Regarding the limitations of claims 2 and 3 Mitchell, Jr. discloses locking tines and suggests the use of solder in column 1 lines 27-30. Regarding claim 6 the display could inherently be replaced in the field. Regarding claim 7 the parameters measured are those inherent in the normal use of the apparatus of Mitchell, Jr. With regard to the limitation of claim 19 the test apparatus is considered a second electronic component. Regarding the limitation of claim 21 modules such as module 20 normally include storage and element 10 is a circuit board.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mitchell, Jr. in view of Bofill et al.

Mitchell, Jr. was discussed above but does not show connection by wire trap. Bofill et al shows connection by wire trap. It would have been obvious to one of ordinary skill in the art at the time of the invention to have adapted the wire trap connection of Bofill et al to the apparatus of Mitchell, Jr. because one skilled in the art would realize that so doing would result in better contact being made.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mitchell, Jr. in view of the prior art of Applicant's Figure 4. Mitchell, Jr. Was discussed above but does not show the use an LED indicator. The prior art of Applicant's Figure 4 shows an LED indicator. It would have been obvious to one of ordinary skill in the art at the time of the invention to have adapted the indicator of the prior art of Applicant's Figure 4 to the apparatus of Mitchell, Jr. because one of ordinary skill in the art would realize that so doing would result in greater reliability with lower power consumption.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Fleckenstein, Cook, Cronin, Thaxton, Nijman and Huchabee et al are all cited to show additional apparatus and method similar to that of Mitchell, Jr..

Any inquiry concerning this communication should be directed to Ernest F. Karlson at telephone number 703-305-4768.

Ernest F. Karlson

September 30, 2003


ERNEST KARLSEN
PRIMARY EXAMINER